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| 10/743,491 | 12/23/2003 | Toshimitsu Ichiyanagi | 016907-1592 | 7810 |
| 22428 | 7590 | 06/04/2007 | EXAMINER | |
| FOLEY AND LARDNER LLP | | | WYATT, KEVIN S | |
| SUITE 500 | | | ART UNIT | |
| 3000 K STREET NW | | | 2878 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/743,491

Applicant(s)

ICHIYANAGI, TOSHIMITSU

Examiner

Kevin Wyatt

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,9,13,15 and 18-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,13,18-21,28,30 and 31 is/are rejected.
- 7) ☒ Claim(s) 9,15,22-27 and 32-34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/02/2007 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 18-21, line 2, the recited limitation "inherently printed" is unclear. It is not clear whether or not "inherently printed" means that the recording medium has an image due to a previous copying operation or a previous manufacturing process prior to performing copying operation.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 2878

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7, 13, 18, 20, 28, and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinoda (Publication No. U.S. 2003/0133153 A1) in view of Yoda (Publication No. U.S. 2003/0164974 A1).

Regarding claim 7, Shinoda shows in Fig. 1, a copying machine comprising: an optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) which optically scans a surface of a recording medium (25), and converts an image on the surface of the recording medium into image data (35 i.e., recorded information of a file, paragraph 0020, line 11); a first radio communication unit (combination of wireless network and chip is reader terminal (71)) which reads data from an IC chip embedded in the recording medium and having a radio communication function (paragraph 0020, lines 1-11) which reads data on the surface of the recording medium from an IC chip (45) embedded in the recording medium (25); an image forming unit (60, i.e., printer) which prints an image on a surface of an image forming medium (20) (paragraph 0019, lines 4-7); and an operational mode setting unit (14, i.e., program database) which sets one of the data of the recording medium acquired by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) and the data read from the IC chip (25) of the recording medium by the first radio communication unit, as the data to be printed as the image on the image forming medium by the image forming unit, in accordance with the user's selection input to the control panel; and the image forming unit (60, i.e., printer) to print the image read by the first radio communication unit on the image forming medium; and when the operational

Art Unit: 2878

mode setting unit (14, i.e., program database) sets the image to be printed on the surface of the image forming medium as the image that is on the surface of the recording medium, control the optical reading unit to read the image on the surface of the recording medium, and the image forming unit (60, i.e., printer) to print the image read by the optical reading unit on the surface of the image forming medium. Shinoda does not disclose reading or recording image data from an IC chip embedded in the recording medium. In addition, a control panel which allows a user to select an image to be printed on the surface of the image forming medium from one of the image on the surface of the recording medium, or a control unit configured to: when the operational mode setting unit sets an image to be printed on a surface of an image forming medium as the image that is recorded in an IC chip of the recording medium, control the first radio communication unit to read an image from the IC chip of the recording medium. Yoda discloses reading and recording image data from an IC chip embedded in the recording medium. In addition, Yoda discloses a control panel (computer terminal, paragraph 0022) which allows a user to select an image to be printed on the surface of the image forming medium (14, i.e., printing unit) from one of the image on the surface of the recording medium (paper roll). Yoda also discloses a control unit (10, laboratory) configured to: when the operational mode setting unit (13) sets an image to be printed on a surface of an image forming medium as the image that is recorded in an IC chip of the recording medium, control a first radio communication unit (transmission means to server) to read an image from the IC chip of the recording medium. It would have been obvious to one skilled in the art to provide the printing medium of Yoda to the device of

Art Unit: 2878

Shinoda for the purpose of providing additional file sharing capabilities, storing image data in addition to authentication data.

Regarding claim 13, Shinoda further shows in Fig. 1, a copying machine comprising: a scanner (71, i.e., reader terminal) unit which includes the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) and the first radio communication unit (combination of wireless network and chip is reader terminal (71)); a printer (60) which includes the image forming unit, and a system controller which includes the operational mode setting unit (14, i.e., program database) and the control unit (combination of program database(14), id managing database (12), managing server (10), wireless network, and id managing center (50)), wherein the control panel, the scanner unit, the printer, and the system controller constitute an integrally formed copying machine.

Regarding claims 18 and 20, Shinoda discloses the claimed invention as stated above. Shinoda does not disclose that the radio reader reads electronic data, which corresponds to the image data recorded on the surface of the recording medium, from the IC chip embedded in the recording medium. Yoda discloses a printing medium having an IC chip, which permits image data to be read wirelessly from the chip (paragraph 004, lines 19-27). It would have been obvious to one skilled in the art to provide the printing medium of Yoda to the device of Shinoda for the purpose of providing additional file sharing capabilities, storing image data in addition to authentication data.

Regarding claim 28, Shinoda discloses method of copying an image on a surface of a recording medium, comprising: optically scanning, by an optically scanning unit, the surface of the recording medium, and converting an image on the surface of the recording medium into image data (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9); printing, by an image forming unit (60), an image on a surface of an image forming medium; receiving a selection made by a user onto a control panel (paragraph 0012, lines 7-10), the selection corresponding to an image to be printed on the surface of the image forming medium from one of the image on the surface of the recording medium; setting one of the image data of the recording medium acquired by the optically scanning step and the data, in accordance with the user's selection input to the control panel; and controlling, when the operational mode setting unit (14, i.e., program database) sets the image to be printed on the surface of the image forming medium (30) as the image that is on the surface of the recording medium, the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) to read the image on the surface of the recording medium, and controlling the image forming unit to print the image read by the optical reading unit on the surface of the image forming medium (30). Shinoda does not disclose reading and recording image data to and from in IC chip embedded in an image recording medium or an image forming medium. Yoda discloses reading and recording image data to and from in IC chip embedded in an image recording medium or an image forming medium. It would have been obvious to one skilled in the art to provide the

Art Unit: 2878

printing medium of Yoda to the device of Shinoda for the purpose of providing additional file sharing capabilities, storing image data in addition to authentication data.

Regarding claims 30-31 Shinoda further discloses generating history information based on contents of processing; and writing, by the first radio communication unit, the history information generated by the generating step in the IC chip of the recording medium and generated by the control unit in the IC chip of the image forming medium (see Fig. 2).

Allowable Subject Matter

6. Claims 9, 15, 23-27, 29 and 32-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claim 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 9 has allowable subject matter because the prior art fails to disclose or make obvious, either singly or in combination, a copying machine, comprising, in addition to the other recited features of the claim, "controlling the first radio communication unit to read the image from the IC chip of the recording medium, and the second radio communication unit to record the image that is read by the first radio communication unit in the IC chip of the image forming medium."

Claim 29 has allowable subject matter because the prior art fails to disclose or

Art Unit: 2878

make obvious, either singly or in combination, a method of copying an image on a surface of a recording medium, comprising, in addition to the other recited features of the claim, "the first radio communication unit to read the image from the IC chip of the recording medium, and controlling the second radio communication unit to record the image that is read by the first radio communication unit in the IC chip of the image forming medium."

Response to Arguments

8. Applicant's arguments filed 03/16/2007 have been fully considered but they are not persuasive.

In response to applicant's arguments that Shinoda or Yoda neither teaches nor suggests a control panel that allows a user to select an image to be printed on a surface of an image forming medium from one of an image that is printed on the surface of a recording medium and image data stored in an IC embedded in a recording medium, the examiner disagrees. The combination of Shinoda and Yoda suggests these limitations due to the fact that Yoda provides image data stored in an IC embedded in a recording medium and Shinoda and Yoda both provide the user selection features (via computer terminal and server).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Wyatt whose telephone number is (571)-272-5974. The examiner can normally be reached on Monday-Friday.

Art Unit: 2878

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on (571)-272-2328. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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